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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/813,104	03/07/97	SMITH	D MUR-3493
		22M2/0602	EXAMINER
		MOSKOWITZ, N	ART UNIT
		2202	PAPER NUMBER
		17	
		DATE MAILED:	06/02/97

This is a communication from the examiner in charge of your application.  
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#### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 3/2/97

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1 - 6 and 8 - 13 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1 - 6 and 8 - 13 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) 108 / 30309

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- Notice of Reference Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

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Art Unit: 2202

1. Applicant's letter received March 7, 1997 has been entered. An action on the pending application follows.
2. The text of those section of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-6 and 8-13 are rejected under 35 U.S.C. § 103 as being unpatentable over Montgomery ('908) or Bockhorst et al when taken with Grossman and Close et al or Arriens.

In determining obviousness, the following factual determinations are made:

- a. first, the scope and content of the prior art;
- b. second, the difference between the prior art and the pending claims;
- c. third, the level of skill of a person of ordinary skill in this art; and
- d. fourth, whether other objective evidence may be present, which indicates obviousness or nonobviousness. Graham v. John Deere Co., 383 US. 1 17-i, 148 USPQ 459, 466-67 (1966). Objective evidence includes a long felt but unmet need for the claimed invention, failure of others to solve the problem addressed by the claimed invention, imitation or copying of the claimed invention, and commercial success due to the features of the invention and not other factors. See e.g., Simmons Fasterner Corp. v. Illinois Tool Works, Inc. 739 (Fed. Cir. 1984).

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Examining the scope and content of the prior art we find the following:

a) Montgomery and Bockhorst et al disclose a method, and apparatus, for transmitting data in a borehole. In Montgomery pressure transducer 707 provides an electrical signal representative of downhole pressure. Transducer 40 then converts the electrical signals to sonic signals generated along the pipe string. The sonic signals then pass uphole past any solid physical obstruction in the well and are converted by uphole transducer 23 to electrical signals. However, no data is stored uphole. It is noted that this reference also discloses the use of a microprocessor (704) downhole.

This system of sonic data transmission is noted to be superior to conventional hardware and electromagnetic transmission, as they require complex hardware (Montgomery at column 1, lines 67-68 and column 2, lines 1-14).

In Bockhorst et al borehole pressure data is logged and acoustically transmitted uphole along the drill string. See especially columns 1, 3 and 4.

b) Grossman teaches:

- 1) Downhole pressure data storage (pages 2 and 3); and
- 2) pick-up tool coupling for data retrieval (overshot device).

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Close et al is representative of modern borehole logging of pressure, and downhole data storage. Arriens et al shows recording the data uphole prior to transmission to the earth's surface.

In addition, applicant has agreed that downhole data logging and storage are known in the prior art, as is inductive coupling to a retrieval tool. The problem of shut-in valve blockage is set forth as conventional (amendment, page 4).

Secondly, under Deere, the difference between this prior art and the pending claims lies in the combination of acoustic uphole data transmission over a section of a borehole tube with recording of the data at the acoustic receiver prior to pick-up tool transmission.

Third under Deere, one skilled in this art generally has graduate degree in geophysics and over seven (7) years of experience. One need only to look at the articles in any issue of Geophysics and Geophysical Prospecting, the leading journals in this field, to realize the technical complexity of this field and the amount of graduate school study and field experience necessary to work in this art.

To date no evidence of secondary considerations (objective evidence) has been presented.

Therefore as the prior art shows the uphole recordation of the received pressure data to be conventional, as is the sonic

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signal transmission along the pipe, the combination would not have been unobvious to one skilled in this art.

4. Applicants' arguments have been considered and are not convincing. First of all, the references must be considered as an ordinary skilled artisan would consider them. See In re Jacoby, 309 F. 2d 513, 135 USPQ 317, 319 (CCPA 1962) (obviousness question cannot be approached on basis that skilled artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclose); In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969) (conclusion of obviousness may be made "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular references").

The assertion that acoustic data transmission between downhole and the surface was never successfully implemented in practice is not cogent. First of all, while noise is problematic in LWD and MWD systems with lengthy drill piping, in situations where the measuring does not take place during drilling the noise problem is clearly not substantial. In addition, the present claims do not recite MWD or LWD operation, nor do they recite the length of tube over which communication is consummated.

Moskowitz/gj-25

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